

### **Remarks/Arguments**

Please reconsider the application in view of the above amendments and the following remarks.

#### **Status of Claims**

Claims 1, 3-14 and 16-22 have been rejected. Claims 1, 10, and 14 are amended. Claims 3, 6, 7, 11, 13, 16, 19 and 20 have been canceled. Claims 1, 4, 5, 8-10, 12, 14, 16-18, 21, 22 remain pending.

Independent claims 1, 10 and 14 have been amended to provide further clarification. In particular, claim 1 has been amended to incorporate subject matter previously recited in dependent claims 3, 6, and 7. As amended, claim 1 recites “first and second play buttons configured to activate the audio player” and associated with front and back side images, respectively, and “a control circuit configured to select one of the audio segments to broadcast based on activation of the first play button or the second play button and activation of one or none of the one or more frame selection buttons.” Support for this amendment may be found in the original disclosure, for example, in the original dependent claims, paragraph 0040 and FIG. 8. As stated in the specification, [t]he user plays the audio segment by pressing one of the frame selection buttons 814, 816, 818, 820 and pressing either the front play button 822 or the back play button 823.” Independent claims 10 and 14 have similarly been amended to incorporate this subject matter previously recited in dependent claims 13, 16, 19 and 20.

#### **Telephonic Interview**

Applicants appreciate the telephonic interview courteously granted by the examiner on February 11, 2009. Applicants’ attorney of record discussed the rejection, particularly the proposed modification of the Chan patent, and proposed an amendment to the independent claims. The examiner appeared to agree that the amendment distinguished over the prior art of record but indicated that an additional search may be necessary.

#### **Rejections under 35 U.S.C. §103**

Claims 1, 3-6, 8, 9, 14, 16-19, 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 6,393,401 to Loudermilk et al. (“Loudermilk”) in view of U.S.

Pat. No. 7,103,552 to Cornwell (“Cornwell”), U.S. Pat. No. 6,446,376 to Chan (“Chan”) and Brookstone (“Talking Photo Album”). Applicants respectfully traverse this rejection.

Applicants submit that one of ordinary skill in the art would not modify pivotally supported frames taught by Chan as proposed in the Office Action because the combination would change the principle of operation of the references. See MPEP 2143.01(VI). In particular, even if Chan could be combined with Cornwell and Loudermilk, further modifying the combination to have “linear non-pivotal movement” would destroy the principle of operation. Chan explicitly states “[i]t is preferred that the cover and the frames are supported for pivotal movement about a common hinge axis.” See Chan, col. 1, lines 22-23. As such, Chan teaches that pivotal movement is preferred, whereas the claimed invention requires “linear non-pivotal movement.” The proposed modification thus would require a substantial reconstruction and a redesign of the elements shown in Chan as well as a change in the basic principle under which the Chan device was designed to operate. Quite simply, such a modification would not have been obvious to one of ordinary skill in the art. See MPEP 2143.01(VI), citing In re Ratti, 270 F.2d 810, 813, 123 USPQ 349, 3352 (CCPA 1959).

The Office Action states that “[o]ne of ordinary skill in the art, furthermore, would have expected Chan system, and applicant’s invention, to perform equally well with either the pivotal movement taught by Chan or the claimed linear non-pivotal movement...” Applicants respectfully disagree. One of ordinary skill in the art reading the Chan patent would have understood that Chan expressed a preference for pivotal movement and that pivotal movement was the basic principle of operation of the photo display unit in Chan. As such, the skilled person would not have concluded from Chan that a linear non-pivotal movement would perform equally well. Applicants respectfully submit that hindsight reasoning appears to have been used to arrive at this conclusion stated in the Office Action.

Moreover, applicants submit that the combination of references proposed in the Office Action fails to result in an image display with each and every element and limitation recited in the claims, as amended. Applicants are unable to find any disclosure in any of the cited references of frame selection buttons (or selection switches) that select both an interior frame for mechanically positioning out of the display housing and an associated audio message to be

broadcast. The movable selectors 70 in Chan simply are not capable of the function of selecting audio messages, and modifying Chan to provide this functionality would not have been obvious.

Furthermore, applicants are unable to find any disclosure in any of the cited references of first and second play buttons associated with front and back images and a control circuit that selects one of the audio segments to broadcast based on activation of the first or second play button and activation of a frame selection button. In rejecting the dependent claims reciting first and second play buttons, the Office Action relies on U.S. Patent No. 5,954,514 to Haas. Although Haas mentions a left photo play back switch 156 and a right photo play back switch 158, Haas does not disclose a frame selection button that selects both an interior frame for mechanically positioning out of the display housing and an associated audio message to be broadcast. Haas thus does not render obvious the combination of the first and second play buttons and the frame selection buttons, which are activated together to cause broadcast of audio segments associated with either the front or back images on interior frames that are mechanically positioned by linear non-pivotal movement in response to activation of the frame selection button.

Thus, the proposed combination of Loudermilk, Cornwell, Chan, and Brookstone would not have been obvious to one of ordinary skill in the art at the time the invention was made and would not have resulted in the image display recited in independent claims 1 and 14. Accordingly, applicants request withdrawal of the rejection of independent claims 1 and 14, and any claims dependent therefrom, under 35 U.S.C. 103(a) over the Loudermilk/Cornwell/Chan/Brookstone combination.

Claims 7 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Loudermilk, Cornwell, Chan, Brookstone and further in view of U.S. Pat. No. 5,954,514 to Haas et al. ("Haas"). Because dependent claims 7 and 20 have been canceled, this rejection is moot.

Claims 10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Loudermilk in view of Cornwell, Chan, and Brookstone. Applicants respectfully traverse this rejection.

Independent claim 10 is directed to a method for associating audio segments with images in an image display. The method claim 10 recites activating a frame selection button to display interior images by mechanically positioning a respective frame and selecting and playing an

audio segment associated with an interior image based on receiving a signal from the activated frame selection button and a signal from a first or second play button.

In making this rejection, the Office Action relies on the same Loudermilk/Cornwell/Chan/Brookstone combination used to reject independent claims 1 and 14. For the same reasons discussed above in connection with independent claims 1 and 14, applicants submit that one of ordinary skill in the art would not combine the references as proposed in the Office Action. Moreover, applicants submit that the combination of references proposed in the Office Action fails to result in the method recited in claim 10, as amended. In particular, the proposed combination would not result in a method that selects and plays an audio segment associated with an image based on receiving a signal from the activated frame selection button and receiving a signal from a first or second play button. Chan, which is relied on as teaching frame selection, does not disclose or teach a frame selection button activation that would also result in selecting and playing an audio segment. Furthermore, the proposed combination of references fails to result in a method that selects and plays an audio segment associated with an exterior image when none of the frame selection button signals are received.

Thus, the proposed combination of Loudermilk, Cornwell, Chan, and Brookstone would not have been obvious to one of ordinary skill in the art at the time the invention was made and would not have resulted in the method recited in independent claim 10. Accordingly, applicants request withdrawal of the rejection of claim 10, and any claims dependent therefrom, under 35 U.S.C. 103(a) over the Loudermilk/Cornwell/Chan/Brookstone combination.

Claims 11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Loudermilk, Cornwell, Chan, Brookstone and further in view of Haas. Because dependent claims 7 and 20 have been canceled, this rejection is moot.

## **Conclusion**

The claims have been shown to be allowable over the prior art. Applicant believes that this paper is responsive to each and every ground of rejection cited by the Examiner in the Action dated October 16, 2008, and respectfully requests favorable action in this application. The examiner is invited to telephone the undersigned, applicant's attorney of record, to facilitate advancement of the present application.

Appl. No. 10/782,437  
Amendment dated February 16, 2009  
Reply to Office action of October 16, 2008

Please apply any charges not covered, or any credits, to Deposit Account 50-3205  
(Reference Number 033964-1050).

Respectfully submitted,

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